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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,783	05/01/2001	Michael Loeb	52846-5003-01	4361

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EXAMINER	
JARRETT, SCOTT L	

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/845,783	LOEB ET AL.	
	Examiner	Art Unit	
	Scott L. Jarrett	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/13/01, 8/2/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 and 3 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

3. Claim 2 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

4. Claims 7 and 8 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 23 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

5. Claim 9 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 18 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

6. Claims 13-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 19 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

7. Claims 34-35, 38 and 45 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

8. Claims 44 and 66 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

9. Claims 48-49, 52 and 59 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 18 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

10. Claim 58 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

11. Claims 63-64 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of prior U.S. Patent No. 6,421,652. This is a double patenting rejection.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 4-6, 10-12 and 16-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well known in the art to pre-generate dynamic/custom information/data (survey, web pages, polls, content, etc.).

More specifically it is old and very well known that the pre-generation of dynamic content reduces the user's "perceived" time required to generate the dynamic content thereby reducing the time users (customers) have to wait for the dynamic content to be made available (displayed); long user wait times (e.g. slow system response times) leave users wondering if the system is operating properly and/or users tend to loose

interest in the task/activity at hand due to slow system response (long wait times) at which point users abandon the system (activity/task).

An additional benefit to pre-generating dynamic content that is old and well known is that such pre-generation helps to reduce the overall load/burden on the system (e.g. pre-generating the dynamic content into static content at night when system demands are low).

Accordingly it would have been obvious to one skilled in the art to pre-generate the dynamic trade publication questionnaires; the resultant system providing dynamic trade publication qualification questionnaires in a more timely fashion thereby avoiding excessive system loads and/or user wait times.

14. Claims 19-21, 28-30 and 31-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because dynamic (e.g. adding or removing questions for the questions to be asked/posed based on information/responses received from the survey taker) surveys (questionnaires, polls, surveys, etc.) is old and very well known in the art.

More specifically it is old and well known to develop questionnaires wherein subsequent questions are based all or in part on the answers provided to previous questions or group of questions; i.e. dynamic questionnaires "pick and choose" (add and remove) which questions to use/present from a plurality of available questions

based all or in part on the users previous responses, thereby enabling the dynamic questionnaire to elicit the appropriate information from users without the need to ask unnecessary or redundant questions.

Accordingly it would have been obvious to one skilled in the art at the time of the invention that method/system for providing free magazine subscriptions, specifically the method/system's utilization of user questionnaires, would have benefited from utilizing a plurality of well known survey techniques, methods and systems including but not limited to the use of dynamic questionnaires; the resultant system being more capable of asking questions in an efficient and non-redundant manner based on the users responses.

15. Claims 22-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because creating surveys, questionnaires, polls and the like either manually, via a computer or both is old and very well know.

Accordingly it would have been obvious to one skilled in the art that the method/system for generating a questionnaire that is used to determine if a consumer qualifies to receive a free trade publication would have utilized a plurality of means for creating the questionnaire including but not limited to utilizing manual and or computer assisted techniques well known in the art.

16. Claims 36 and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because as per applicant's own admission it is old and very well known that suppliers (publishers, etc.) limit the number of free subscriptions to their magazines (TradePub.com- The premier Internet service for professional trade publications (1998): Page 2; "The publishers reserve the right to limit the number of subscriptions....").

Accordingly it would have been obvious to one skilled in the art t at the time of the invention that the method/system for providing free subscriptions to magazines would enables suppliers to limit the number of free subscriptions awarded (provided, supplied, given) to consumers to supplier's magazines thereby insuring that the number of subscribers does not exceed the supplier's ability to print (produce) and/or distribute the magazine.

17. Claims 37, 39, 51 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because the ordering of content (information, product offers, search results, etc.) in a particular order, especially an order in which certain information (results) are presented more prominently (before) than others based on a plurality of business criteria such as profit potential (e.g. referral

fees, commissions, advertising revenue, click thoughts, etc.), existing business relationship (partner site) and the like is old and well known.

For example Internet search engines (e.g. Yahoo) enable business to pay for increasing levels of prominence/exposure during a users search (buy keywords, bold print, right/left column, top of search results, etc.). Businesses are willing to pay for the increased exposure since such prominence in the search results tends to increase the number of users viewing the information (exposure) and because the increased exposure can lead to things such increased sales or increased brand awareness.

Accordingly it would have been obvious to one skilled in the art at the time of the invention that the method/system for providing free subscriptions to magazines would have utilized a plurality of well known business practices for generating revenues including but not limited to making certain subscriptions to magazines more prominent (ahead, top of the list, bold text, larger text, etc.) during the subscription selection process thereby enabling the system to charge higher fees for such preferential placement.

18. Claims 40 and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because the creation and utilization of dynamic (branching, decision-tree-based, interactive, etc.) surveys (questionnaires, polls, surveys, etc.) is old and very well known in the art. More specifically it is old and

well known to develop questionnaires wherein subsequent questions are based all or in part on the answers provided to previous questions or group of questions thereby enabling the questionnaire to elicit the appropriate information from users without the need to ask unnecessary or redundant questions.

Accordingly it would have been obvious to one skilled in the art at the time of the invention that method/system for providing free magazine subscriptions, specifically the method/systems utilization of user questionnaires, would have benefited from utilizing a plurality of well known survey techniques, methods and systems including but not limited to the use of dynamic questionnaires; the resultant system being more capable of asking questions in an efficient and non-redundant manner based on the users responses.

19. Claims 41-42 and 55-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because by virtue of the method/system for providing free magazine subscriptions being made generally available on the Internet (World Wide Web; e.g. www.tradepub.com, www.freebizmag.com) the method/system is accessible by anyone (general population, untargeted, un-segmented) with an Internet connection (TradePub.com, The premier Internet service for professional trade publications (1998): Pages 1-2).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention that the method/system for providing free subscriptions to magazines was generally available on the Internet to a plurality of untargeted/un-segmented groups of consumers thereby enabling the method/system to reach a potentially larger audience for the supplier's (publisher's) goods/services (magazines).

20. Claims 43 and 57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is old and well known in advertising, marketing and the like to present offers (surveys, polls, advertisements, etc.) to a plurality of users/groups which are selected/targeted/solicited based on a plurality of factors and/or approaches.

One such approach being to sample the general population randomly (e.g. market polls) wherein users are selected at random; random groups providing a means for determining or assisting in determining the potential group/segment of users who would find the offer, product, service, etc. appealing (new potential, untapped demand, etc.).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to target a random group of users (groups) with a method/system (offer) for providing free subscriptions to magazines thereby finding a potentially larger audience for the supplier's (publisher's) goods/services (magazines).

21. Claims 47 and 61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15, 18 and 22-23 of U.S. Patent No. 6,421,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is old and well known that there exists a plurality of channels (communication means) by which customers and business can interact and that business support these various communication channels by providing customers with the ability to contact/conduct business with the business via one or more of the plurality of communication channels (e.g. Internet web site, telephone service center/call center, Interactive Voice Response systems (IVR), etc.).

Further it is old and well known that each of these communication channels is capable of utilizing one or more input devices (modules) including but not limited to voice recognition systems (e.g. IVR system that utilizes voice recognition system to recognize/capture/respond to a users voice responses instead of requiring the user to use the telephone keypad).

Accordingly it would have been obvious to one skilled in the art at the time of the invention to enable consumers (users) to interact with the system/method for providing fee subscriptions to magazines via an interactive voice response system further comprising a voice recognition system (subsystem) thereby enabling consumers an additional and convenient means for receiving free magazine subscriptions.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Dworkin, Ross E., U.S. Patent No. 4,992,940, teaches a method and system for enabling consumers (users) to identify items (products, services, etc.) that meet certain qualifications (requirements, characteristics). More specifically Dworkin teaches a system and method for providing users with item recommendations (guidance) and enabling users to order (purchase) those items (e.g. identify magazine subscriptions meeting a specified set of qualifications wherein the qualifications desired are entered using forms).

- Salmon et al., U.S. Patent No. 5,592.375, teach a system and method for enabling consumers to identify and order items (products, services, merchants, etc.) that meet certain qualifications.

- Peters et al., U.S. Patent No. 5,893,098, teach a dynamic survey method and system wherein questionnaires are dynamicly generated based on previous user responses and other information/data.

- Blumfoe, Ari, U.S. Patent Publication No. 2001/0025260, teaches a method and system that enables consumers to select and order one or more magazine subscriptions from a list of available magazine subscriptions as well as select a desired subscription period.

- Feit et al., U.S. Patent Publication No. 2001/0056354, teach a method and system for providing magazine subscriptions to magazines (trade publications) wherein

consumers are presented a consolidated (universal) dynamic questionnaire to qualify (qualification requirements) for multiple subscriptions (free magazine subscriptions, goods, memberships, etc.), a list of available/qualified magazines (services) among which the user selects which magazines to subscribe to and then an order for the subscription is placed with the supplier. Feit et al. further teach that the magazine subscription system comprises a plurality of subsystems (engines) including data collection (collects consumer qualification information), parsing (normalizes consumer qualification information), filtering, formatting (formats consumer data from common data format to supplier specific data format), messaging and transmission.

- Edwards et al., U.S. Patent Publication No. 2003/0016202, teach a system and method that enables consumers (users) to identify items (products, services, etc.) that meet certain qualifications (generates a product set that meets selection criteria).

- Sibler, Debra, New class of e-vendor follows the magazine industry to the Web, teaches the commercial availability of an online system and method for providing free subscriptions to trade publications (freebizmag.com).

- Inforefinery.com web pages teaches an online system and method provides users with a universal survey for ordering trade publications (trade catalogs).

- Netline.com web pages teaches a commercially available online system and method that provides free subscriptions to trade publications utilizing a plurality of surveys.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SJ
4/18/2005

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